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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,681	01/31/2000	JOACHIM BLUM	PM266043	6649
909	7590	10/22/2003	EXAMINER	
PILLSBURY WINTHROP, LLP			MAYEKAR, KISHOR	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1753	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/463,681

Applicant(s)

BLUM ET AL.

Examiner

Kishor Mayekar

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Sept. 29, 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection. Also, the finality of the last Office action is withdrawn.

### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02300281A in view of SOLTWEDEL et al. (5,624,978). The rejection to claims 1-11, 13, 14 and 19 stands for reasons as of record (see the rejection of April 30, 2003 in paper #25).

As to the subject matter of each of claims 15-18, the selection of film to be opaque, transparent, pigmented or translucent would be within the level of ordinary skill in the art.

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over SOLTWEDEL '978 in view of HAMER et al. (5,804,610). SOLTWEDEL's invention is directed to an aqueous composition useful for depositing coatings on metallic substrates in order to protect substrates against corrosion. SOLTWEDEL discloses the use of the aqueous coating composition in the automotive industries which renders a metallic substrate capable of severe drawing without sacrificing corrosion protection or electrocoatability and the steps of applying the aqueous coating composition on the metal substrate utilizing known coil coating process and by any other known coating techniques to form a basecoat, and stoving the basecoat (col. 11, lines 11-18), where the basecoat has conductive properties imparted by conductive pigments in the coating composition (col. 10, lines 40-48). SOLTWEDEL also discloses that the basecoat substrate can then be conventionally coated or electrocoated with primer coatings (see abstract; col. 2, lines 54-59; and Examples 1 and 2). The difference between SOLTWEDEL and the claims is the recited step of bonding. HAMER shows the use of a packaged, thermoplastic hot melt pre-adhesive as self-tick articles or retroreflective sheetings to be applied to vehicle bodies (col. 14, line 48 through col. 15, line 58). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time

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the invention was made to have modified SOLTWEDEL's teachings as suggested by HAMER because this would result in decorative effects on vehicle bodies.

As to the subject matter of claims 4 and 11, SOLTWEDEL discloses that the basecoat is on both sides of the metal coil substrate (col. 9, lines 52-57).

As to the subject matter of claim 5, SOLTWEDEL discloses that the basecoat is formable and may be weldable (col. 11, lines 30-31).

As to the subject matter of claim 6, SOLTWEDEL discloses the spot welding of the basecoat steel panels (col. 11, lines 64-66).

As to the subject matter of claim 8, SOLTWEDEL discloses that the aqueous composition is useful to provide pretreatment coatings on metal substrates used in the automotive industry (col. 2, lines 47-50).

As to the subject matter of claim 14, the selection of coating thickness would be within the level of ordinary skill in the art.

### ***Response to Arguments***

5. Applicant's arguments filed September 29, 2003 have been fully considered

but they are not persuasive in view of the new ground of rejections as set forth above.

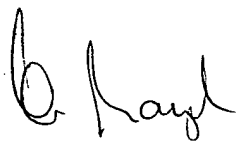
As to the argument that that there is no disclosure or suggestion of laminar coating in JP '281, the Examiner would like to point out to Applicant that JP '281 clearly discloses the step of applying a protective film (a protective layer) on the surfaces of newly coated cars. As to the argument on "decorative" in the first paragraph of page 3, since a protective film is applying to protectively cover surfaces of newly coated cars, the protective film inherently possesses the decorative effect. Further, "change in aesthetic (ornamental) design" has been held to be obvious, *In re Seid* 73 USPQW 431.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Kishor Mayekar', is positioned above the printed name.

Kishor Mayekar  
Primary Examiner  
Art Unit 1753

KM